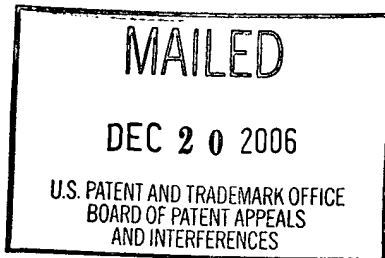


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex Parte YOON KEAN WONG, DAVID KAMMER,
RUSSELL Y. WEBB, and STEVEN C. LEMKE



Appeal No. 2006-3147
Application No. 09/998,079

ON BRIEF

Before HAIRSTON, JERRY SMITH, and SAADAT, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1, 3-11, 13-21, and 23-29, which constitute all the claims pending in this application.

The disclosed invention pertains to a method and apparatus for indexing information stored on a portable electronic device.

Representative claim 1 is reproduced as follows:

1. A method of indexing information stored on a portable electronic device, comprising:
 - receiving an association signal by the portable electronic device the association signal providing an indication of adjacent resources;
 - accessing a database including a table storing relationships between data stored on the portable electronic device and the association signal; and
 - indexing the data based on the relationships accessed in the database;
 - prioritizing the indexed data.

The examiner relies on the following references:

Albukerk et al. (Albukerk)	5,929,848	Jul. 27, 1999
Schulze et al. (Schulze)	US 2002/0019584	Feb. 14, 2002 (filed May 18, 2001)
Colson et al. (Colson)	US 2002/0078075	Jun. 20, 2002 (filed Dec. 15, 2000)

Claims 1, 3-11, 13-21 and 23-29 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Albukerk in view of Colson with respect to claims 1, 3, 7-11, 13, 16, 18-21, 23, 26, 28, and 29, and Schulze is added to this combination with respect to claims 4-6, 14, 15, 17, 24, 25, and 27.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the claims on appeal. Accordingly, we affirm.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). The examiner must articulate reasons for the examiner's decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. Id. at 1343, 61 USPQ2d at 1433-34. The examiner cannot simply reach conclusions based on the examiner's own understanding or experience - or on his or her assessment of what would be basic knowledge or common sense. Rather, the examiner must point to some concrete evidence in the record in support of these findings. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus the examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined

teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kahn, 441 F.3d 977, 987-88, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (citing In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000)). See also In re Thrift, 298 F.3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

We consider first the rejection of claims 1, 3, 7-11, 13, 16, 18-21, 23, 26, 28, and 29 based on Albukerk and Colson. We note that appellants have made identical arguments with respect to independent claims 1, 11 and 21, and appellants have indicated that each of the dependent claims is patentable based only on its dependency from one of these independent claims. Therefore, we can consider the examiner's rejection with respect to any of the independent claims as representative of all claims which are subject

to this rejection. For purposes of this appeal, we will consider the rejection with respect to independent claim 1 as the representative claim for this rejection.

The examiner has indicated how the invention of these claims is deemed to be rendered obvious by the collective teachings of Albukerk and Colson [answer, pages 4-7]. Specifically, the examiner finds that Albukerk teaches the claimed invention except for the step of prioritizing the indexed data. The examiner finds that Colson teaches this feature. The examiner concludes that it would have been obvious to the artisan to incorporate the teachings of Colson into the device of Albukerk in order to store and process the priority data from the database.

With respect to each of independent claims 1, 11, and 21, appellants argue that the examiner has failed to provide motivation or support for combining the teachings of Albukerk and Colson. More particularly, appellants argue that the examiner has not pointed to any express or implied recognition in Albukerk or Colson, or any convincing line of reasoning, that any advantage cited in Colson would be produced by combining the references. Appellants also argue that Colson teaches away from the invention of the independent claims. Appellants note that the prioritization taught by Colson is part of a synchronization process between two memory devices and does not involve prioritizing indexed data on a single device. Appellants assert, therefore, that the artisan would not have been motivated to modify the teachings of Albukerk to include the prioritization system of Colson to arrive at the invention of the independent claims [brief, pages 7-16].

The examiner responds that sorting data in order by giving priority to data is well known in the art. With respect to the motivation to combine argument, the examiner responds that it would have been obvious to incorporate the teachings of Colson into

Albukerk in order to store and process the priority data in the database so that only the highest priority data is stored on the limited storage resources of the client device as suggested by Colson. The examiner also responds that Colson does not teach away from the claimed invention and that the examiner is only relying on the broad concept of prioritizing data from Colson [answer, pages 7-11].

Appellants respond by essentially repeating arguments made in the main brief [reply brief, pages 2-4].

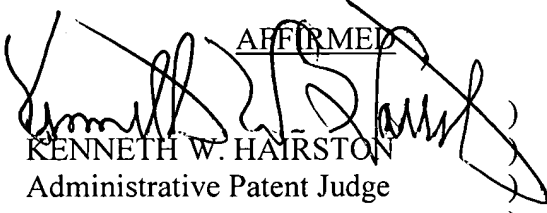
We will sustain the examiner's rejection of claims 1, 3, 7-11, 13, 16, 18-21, 23, 26, 28, and 29 based on the collective teachings of Albukerk and Colson. We agree with the examiner that the broadly claimed step of prioritizing data would have been obvious to the artisan in view of Colson and in view of the well known advantages of prioritizing data for any of a number of reasons. Whenever the amount of data stored exceeds the amount of data that can be conveyed at one time to a user, it is clear that a priority scheme must be used to determine what data will be conveyed to the user first and the order in which the remaining data will be conveyed to the user. It would have been obvious to the artisan to apply this broad concept to the data stored in Albukerk. We also note that appellants' own specification describes prioritizing data based on a number of factors including distance from each of the objects [specification, page 7]. Albukerk teaches that the receiver is configured to accept the strongest signal so that it typically locks onto the signal from the closest object [column 9, lines 32-35]. Therefore, Albukerk teaches prioritizing data based at least on the distance from the object factor. Since this is a prioritizing factor disclosed in appellants' specification, we find that


Albukerk teaches the claimed invention without relying on the cumulative teachings of Colson regarding prioritization.


We now consider the rejection of claims 4-6, 14, 15, 17, 24, 25, and 27 based on Albukerk, Colson and Schulze. Appellants' only argument with respect to these claims is that they are patentable based on their dependency from one of independent claims 1, 11, or 21. Since we have sustained the examiner's rejection of claims 1, 11, and 21, and since appellants have offered no separate arguments with respect to these claims, we also sustain the examiner's rejection of these claims for the reasons discussed above.

In summary, we have sustained each of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1, 3-11, 13-21, and 23-29 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

KENNETH W. HAIRSTON
Administrative Patent Judge


JERRY SMITH
Administrative Patent Judge


MAHSHID D. SAADAT
Administrative Patent Judge

) BOARD OF PATENT
) APPEALS AND
) INTERFERENCES
)
)
)

JS/eld

FOLEY & LARDNER LLP
777 EAST WISCONSIN AVENUE
MILWAUKEE WI 53202-5306